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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,269

12/16/2004

Bartel Marinus Van De Sluis

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

NOONAN, WILLOW W

ART UNIT

PAPER NUMBER

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/518,269	Applicant(s) VAN DE SLUIS ET AL.	
	Examiner Willow Noonan	Art Unit 2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/16/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/16/2005</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Title

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 and 4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, both steps of the method involve "determining" the status of the network and a group identifier, but there is no physical transformation nor is there a useful, concrete, and tangible result.

As per claim 4, the additional limitation that the media system is a set-top box, a TV, a PC, a DVD player, a radio, a screen, a camera or a VCR does not produce a physical transformation or a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites the step of determining the status of the network. The definition of status in the specification and in the claim is vague and unclear, and it is not clear how said status can be determined. A method for determining a status of the network cannot be found without undue experimentation.

Claim 7, which recites a means for determining a status of the network, is similarly rejected.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1,2,3,8,9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05.

Claim 2 recites the limitation "a sixth media system". There is insufficient antecedent basis for this limitation in the claim. Claim 1 recites a media system, however there is no mention of second through fifth media systems.

As per claim 3, the first step recites "said media system." However, claim 1 recites "at least one media system." Thus, the reference in claim 3 to "said media system" is unclear. Further, the second step in claim 3 recites a "first media system." However, claim 1 already recites "at least one media system." Furthermore, the last step of claim 3 recites a "first group identifier." However, claim 1 already recites a "group identifier."

As per claim 8, the first element recites a "means for resetting the group identifier, when said media system is disconnected." It is unclear, however, what "said media system" refers to because claim 7 references "a media system" and a "network of media systems." The second element of claim 8 recites "a first media system;" however, claim 7 already recites a "media system" and a "network of media systems." The last element of claim 8 recites a "first group identifier." However, claim 7 already recites a "group identifier."

Claim 9 recites the limitation "a sixth media system". There is insufficient antecedent basis for this limitation in the claim. Claim 7 recites a media system, however there is no mention of second through fifth media systems.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Fong (20050249169) in view of Droms & Lemon (*The DHCP Handbook*, hereinafter Droms). Fong teaches a system, computer program product, and method for managing a network of media systems (electronic devices). See Fong, Abstract. However, Fong does not teach a method for automatically providing a media system with a group identifier. Droms teaches a well-known system for automatically providing computers in a network with, among other things, address and group information. The system in Droms can easily be implemented in a network of media systems such as that which Fong teaches to provide group identifiers to said media systems. This follows from Droms' teaching that the disclosed system for assigning group identifiers can be used

for a wide range of devices. See Droms, *Preface*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Droms' system for automatically providing a media system with a group address in a network of media systems as disclosed in Fong because Droms teaches that the disclosed system can be used to freely add new devices, replace existing devices, and move devices between various locations without requiring user intervention. See Droms, *Preface*.

As per claim 1, Examiner considers the term "media system" to include personal computers in accordance with the specification, page 9, lines 21-23. Examiner further considers the term "group identifier" to be any way of designating sub-groups of media systems. Droms further teaches that on a network of computers, group identifiers are used to designate groups of computers within a network. See Droms, p. 34-35, example 3.2 (allocating computers into groups by locale using subnets). Droms further teaches that when a computer obtains address information, it may learn the group (subnet) information, see Droms, p. 78, and the presence or absence of other systems on the network, see Droms, p. 18 (discussing use of address resolution protocol (ARP) to discover and communicate with other computers on the network). Droms teaches determining the group identifier (subnet address) for a media system (computer) newly attached to a group of devices distinguished by a distinct identifier (a network segment). See Droms, p. 32, *Summary*.

As per claim 2, Droms further teaches that a user may specify distinct groups (subnets) within the network, see Droms, p. 33, and that this configuration information

may be assigned specifically to a particular media system (personal computer), see Droms, p. 20.

As per claim 3, Droms teaches that when a media system is disconnected from the network, the group identifier (address and subnet information) is reset (to the INIT state). See Droms, p. 110, *When a Lease Expires*. Droms further teaches that when a media system (computer) without a group identifier (subnet address) is connected to the network, it will be assigned the same group (subnet) identifier as other media systems in that group (on that subnet). See Droms, p. 33, *Specifying the Basic Intranet Architecture*. Droms also teaches that group identifiers (subnet addresses) can be statically assigned so that particular media systems (computers) always retain the same group (subnet) identifier. See Droms, p. 20, *Static Allocation*. Droms teaches that media systems without group identifiers that are connected together (on the same subnet) will be given the same group identifier (subnet address) specified by another computer (the DHCP server). See Droms, p. 33, *Specifying the Basic Intranet Architecture*.

Claim 4 is rejected for the same reasons as claim 1 because the term "media system" in claim 1, as defined by the specification, already includes set-top boxes, TV's, PC's, DVD players, radios, screens, cameras, and VCR's. See *above*. Furthermore, Fong teaches a system, computer program product, and method for managing a network of media systems (electronic devices), which includes the claimed devices.

As per claim 5, Fong teaches a computer system for managing a network of media systems. See Fong, *Abstract*. Droms also teaches a computer system for

carrying out the method described above (the DHCP server and client computers). See Droms, p. 13, *Availability of DHCP Clients*.

As per claim 6, Fong teaches a computer program product for managing a network of media systems. See Fong, *Abstract*. Droms also teaches a computer program product which is run on computers for carrying out the method described above (included in Windows 95 distribution). See Droms, p. 13, *Availability of DHCP Clients*.

As per claim 7, Droms teaches a media system (computer system) for managing a network of media systems (personal computers) with a group identifier (subnet address). Droms further teaches the means for determining a status of the network and a group identifier. See *above*.

As per claim 8, Droms teaches the media system of claim 7, performing the method of claim 3. See *above*.

As per claim 9, Droms teaches the media system of claim 7, wherein a second group identifier (subnet address) is assigned to a particular media system (computer) by a user. See Droms, p. 20, *Static Allocation* (discussing manual assignment of static address and subnet information).

Please see the included *Notice of References Cited* for additional prior art considered pertinent to applicant's disclosure but not explicitly relied upon in this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willow Noonan whose telephone number is (571) 270-1322. The examiner can normally be reached on Monday through Friday, 7:30 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Willow Noonan". The signature is written in a cursive, flowing style.